

REMARKS

Previously Claims 136-155 and 203-226 were pending. In the instant amendment, Claims 136, 140, 149, 154, 155, 209, 210, 212-214, 216, 219, 220, 223, 224 and 226 have been canceled without prejudice to Applicants' right to pursue canceled subject matter in one or more related applications. Claims 137, 138, 141-148, 150-153, 203-205, 217, 218, 221 and 225 have been amended. After entry of the instant amendment, Claims 137-139, 141-148, 150-153, 203-208, 211, 215, 217, 218, 221, 222 and 225 will be pending and under consideration.

I. AMENDMENTS TO THE CLAIMS

Claims 136, 140, 149, 154, 155, 209, 210, 212-214, 216, 219, 220, 223, 224 and 226 have been canceled without prejudice.

Claims 141, 146 and 151 have each been amended to an independent form.

Claim 148 has been amended to an independent form and to recite, in pertinent part, that R³ is a member selected from the group consisting of (C₁-C₈)alkoxy, (C₃-C₉)heterocyclyl and (C₁-C₈)acylamino. This amendment is supported by page 13, lines 19-21 of the specification as filed, for example. Applicants submit that Claim 148 recites allowable subject matter as discussed below.

Claims 137, 138, 142-145, 147, 150, 152, 153, 203, 204, 217, 218, 221 and 225 have been amended in their dependencies and to remove repetitive definitions resulting from the change in dependencies.

Claim 205 has been amended to recite, in pertinent part, that R⁴ is substituted or unsubstituted benzyl, wherein said substituents are selected from the group consisting of halogen, halo(C₁-C₄)alkyl, halo(C₁-C₄)alkoxy, cyano, nitro and phenyl. Support for this amendment is found in the specification, for example, at page 19, lines 25-27. Applicants submit that Claim 205 recites allowable subject matter as discussed below.

It is believed that the amendments described above would, if entered, place the instant application in condition for allowance. No new matter has been added with these amendments. As these amendments are fully supported by the specification and claims as originally filed, entry thereof is respectfully requested.

An amendment fee sheet is enclosed.

II. PRIORITY

Applicants agree with the Patent Office that a claim of priority under 35 U.S.C. § 119(e) to U.S. Provisional Application no. 60/296,499 filed June 6, 2001, is proper with respect to Claims 137-139, 141-148, 150-153, 203, 204, 207, 208, 211, 215, 217, 218, 221, 222 and 225.

The Patent Office, however, alleges that Provisional Application no. 60/296,499 lacks adequate support under 35 U.S.C. § 112 for claims 205 and 206 in reference to “R¹⁴ is substituted or unsubstituted aryl or heteroaryl.” As stated on page 17 of Applicants’ Amendment and Response filed September 15, 2003, it is respectfully maintained that support for “R¹⁴ is substituted or unsubstituted aryl or heteroaryl” may be found on page 15, lines 4-5, and page 15, line 34 to page 16, line 1, of Provisional Application no. 60/296,499.

III. ALLOWABLE SUBJECT MATTER

The Patent Office states that Claims 140, 141, 144, 146, 148, 150-152, 203, 204, 209, 210, 213 and 216 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicants respectfully submit that Claims 141, 146, 148 and 151 have been amended to an independent form including all the limitations of the base claims and any intervening claims. Further, Applicants respectfully submit that Claims 144, 150, 152, 203 and 204 have been amended to depend from independent Claims 141, 146, 148 or 151. Accordingly, Applicants respectfully request an indication regarding the allowability of Claims 141, 144, 146, 150-152, 203 and 204.

Regarding Claim 148, as discussed briefly with Examiner McKenzie on July 12, 2004, the term heteroaryl has been deleted from the claim and replaced with the term (C₁-C₈)acylamino. Prior to the instant amendment, Claim 140 recited that R³ could be (C₁-C₈)acylamino, and the Patent Office indicated that Claim 140 recited allowable subject matter. Thus, Applicants respectfully submit that amended Claim 148 recites allowable subject matter from Claims 140 and 148, and for this reason amended Claim 148 should be allowable.

IV. CLAIM REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 154, 155 and 217-226 stand rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not reasonably provide enablement for the claims. Applicants respectfully disagree for the reasons of record in Applicants’ responses mailed September 15, 2003 and January 8, 2004, and therefore do not acquiesce in the rejection.

Nonetheless, the rejection of Claims 154, 155, 219, 220, 223, 224 and 226 is moot in view of their cancellation. Applicants reserve the right to pursue the canceled subject matter in one or more related cases.

It is Applicant's understanding that the Patent Office, in stating that the "specification does not reasonably provide enablement for treating any human disease," is asserting this to be the case with respect to the instant Claims 154, 155 and 217-226, for example, where a genus of compounds is recited for a method of treatment, and not as a general statement that the specification lacks enablement for any and all methods of treating human disease.

Applicants respectfully submit that method Claims 217, 218, 221, 222 and 225 have each been amended to depend directly or indirectly from allowable method Claim 203 or 204, and therefore these claims are believed to be in a form for allowance.

Accordingly, Applicants respectfully request the withdrawal of the rejection of Claims 154, 155 and 217-226 under 35 U.S.C. § 112, first paragraph.

V. CLAIM REJECTION UNDER 35 U.S.C. § 103(a)

Claims 136-139, 142, 143, 145, 147, 149, 153, 154, 205-208, 211, 212, 214, 215, 217, 218, 221, 222, 224 and 225 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,545,005 ("Baxter '005"). Applicants respectfully disagree for the reasons of record in Applicants' responses mailed September 15, 2003 and January 8, 2004, and therefore do not acquiesce in the rejection. Nonetheless, Applicants respectfully submit that the rejection is moot in light of the instant amendments to the claims. In particular, Claims 136, 149, 154, 212, 214 and 224 have been canceled. Claims 137-139, 142, 143, 145, 147, 153, 207, 208, 211, 215, 217, 218, 221, 222 and 225 have been amended directly or indirectly to depend from base claims not included in the rejection. Accordingly, Applicants respectfully request the withdrawal of the rejection of Claims 136-139, 142, 143, 145, 147, 149, 153, 154, 207, 208, 211, 212, 214, 215, 217, 218, 221, 222, 224 and 225 under 35 U.S.C. § 103(a).

With regard to Claims 205 and 206, in the instant amendment to Claim 205, variable R⁴ has been defined to be identical to that recited for R⁴ in Claim 141, which the Patent Office has indicated is allowable subject matter. Accordingly, Applicants respectfully submit that Claim 205, and Claim 206 that depends from Claim 205, recite allowable subject matter. Applicants respectfully request the withdrawal of the rejection of Claims 205 and 206 under 35 U.S.C. § 103(a).

Claims 136-139, 142, 143, 145, 147, 149, 153, 154, 205-208, 211, 212, 214, 215, 217, 218, 221, 222, 224 and 225 stand rejected under 35 U.S.C. § 103(a) allegedly for being obvious over Baxter (WO 01/19800 A2, Ref. AL) essentially for the reasons cited with regard to Baxter '005 discussed above. Applicants respectfully disagree for the reasons of record in Applicants' responses mailed September 15, 2003 and January 8, 2004, and therefore do not acquiesce in the rejection. Nonetheless, Applicants respectfully submit that the rejection is moot in light of the instant amendments to the claims. In particular, Claims 136, 149, 154, 212, 214 and 224 have been canceled. Claims 137-139, 142, 143, 145, 147, 153, 207, 208, 211, 215, 217, 218, 221, 222 and 225 have been amended directly or indirectly to depend from base claims not included in the rejection. With regard to Claims 205 and 206, in the instant amendment to Claim 205, variable R⁴ has been defined to be identical to that recited for R⁴ in Claim 141, which the Patent Office has indicated is allowable subject matter. Hence, Applicants respectfully submit that Claim 205, and Claim 206 that depends from Claim 205, recite allowable subject matter. For the reasons stated above, Applicants respectfully request the withdrawal of the rejection of claims 136-139, 142, 143, 145, 147, 149, 153, 154, 205-208, 211, 212, 214, 215, 217, 218, 221, 222, 224 and 225 under 35 U.S.C. § 103(a).

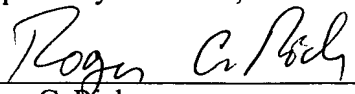
CONCLUSION

In light of the above amendments and remarks, the subject application is believed to be in good and proper order for allowance.

No fees are believed to be due with this paper. However, the Commissioner is hereby authorized to charge any required fee, fee under 37 C.F.R. § 1.17, any underpayment of fees, or credit any overpayment to Jones Day Deposit Account No. 50-3013 in connection to this Amendment and Response.

Date: July 20, 2004

Respectfully submitted,


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